

Page 5

10/633,060 Chiu 4 LUC-419

**Remarks**

Reconsideration of the application and allowance of all claims pending are respectfully requested. Claims 1-10 are pending. The only claim amendments made are to address the 35 U.S.C. 112 rejections.

Applicant's arguments presented below focus on certain patentable differences between the invention as claimed and the applied references. However, it is not to be inferred that the failure to argue all differences between the claimed subject matter and the applied references constitutes acceptance of assertions made in the Office Action of alleged similarities between elements of the claimed subject matter and the applied references.

Claim Rejections - 35 U.S.C. §112

Claims 1-10 were rejected under 35 U.S.C. §112, second paragraph. Claims 1 and 6 were rejected for "an IP telephone set" not having a functional relationship to the "first IP telephone" and the "PSTN switch". These claims are amended to clarify that "an IP telephone set subscriber" refers to one of the IP telephone set subscribers having a relationship with the PSTN switch established in the preamble of claims. Thus, it is believed that this rejection is overcome and is requested to be withdrawn.

Claim Rejections - 35 U.S.C. §103

Claims 1-10 were rejected under 35 U.S.C. §103 as being anticipated by Schessel (U.S. Patent No. 6,304,566) in view of Ress (U.S. Patent No. 6,885,658). This rejection is respectfully traversed.

Re-issuance of the Office Action is Requested

It is requested that the Office Action of January 11, 2008 be withdrawn and reissued with an appropriate communication that addresses the substance of the Applicant's previously presented reasons traversing the prior art rejection of claims 1 and 6 based on Schessel. In the subject Office Action it was stated in the "Response to Arguments" section that:

"Applicant's argument with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection necessitated by Applicant's amendment to claims 1 and 6."

However, mootness of Applicant's arguments is not accurate.

Several of applicant's arguments, which were not based on the claim amendments in the preceding communication, were and remain relevant. For example, in presenting arguments for claim 1, the fact that the IP peripheral unit is part of the PSTN switch and that the PSTN switch itself provides call features to requesting IP telephone sets were explained as not being taught by Schessel. Other arguments and distinctions were made which were and remain relevant, and the substance of which were not addressed in the subject Office Action.

The portion of the 103 rejection of claims 1 and 6 in the Office Action of January 11, 2008 relevant to the points in the above paragraph is the same exact language as used in the Office Action of September 10, 2007 as to Schessel. To this language in the current Office Action related to Schessel, one extra sentence is added related to an IP phone's relationship to the PSTN switch. The added Ress reference is only relied upon with regard to a request containing a telephone directory number of a called party, and hence is not relevant to the above discussed subject matter. This is evidence that Applicant's previously presented arguments and distinctions are still relevant since the same exact explanation of Schessel is presented to which Applicant's prior distinctions were made.

Page 7

10/633,060 Chiu 4 LUC-419

**MPEP 707.07(f) Answer All Material Traversed [R-3]**

... Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it....

Although the statutory basis changed (from 102 to 103), the basis for the rejection relevant to Applicant's previously presented reasons (Schessel), was repeated in the current Office Action.

Also in this section of the MPEP, guidance is give with regard to handling new grounds of rejection.

**Arguments Are Moot Because of New Ground(s) of Rejection**

Applicant's arguments with respect to claim [1] have been considered but are moot in view of the new ground(s) of rejection.

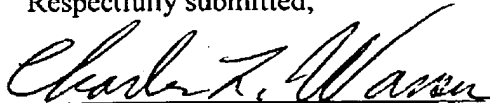
**Examiner Note**

The examiner must, however, address any arguments presented by the applicant which are still relevant to any references being applied. (Emphasis added.)

As explained above, several distinctions between claim 1 and Schessel (still primarily relied upon) pointed out by Applicant were relevant and remain relevant, and do not rely upon the amendments to claim 1, i.e. were and remain present in the claim. Applicant is entitled to have the substance of these distinctions addressed so that a determination can be made by Applicant of the merits of the position taken by the Office.

Therefore, Applicant requests that the Office Action be withdrawn, the distinctions presented relevant to patentability as per Schessel in Applicant's communication of October 22, 2007 be addressed in a further Office Action, and the date for response be reset based on the further Office Action.

Respectfully submitted,



Charles L. Warren  
Attorney for Applicants  
Reg. No. 27,407

Dated: January 29, 2008

PATTI HEWITT & AREZINA, LLC  
Customer Number 47382